



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JGJr : 12-07

NORRIS, MCLAUGHLIN & MARCUS
875 THIRD AVE
18TH FLOOR
NEW YORK NY 10022

COPY MAILED

JAN 04 2008

OFFICE OF PETITIONS

In re Application of	:	
Bennett, et al.	:	
Application No. 10/645,248	:	DECISION
Filed: 20 August, 2003	:	
Attorney Docket No. 102792-158	:	

This is a decision on the petition filed on 15 December, 2005, under 37 C.F.R. §1.182.

The Office regrets the delay in addressing this matter, however, the instant petition was presented to the attorneys in the Office of Petitions only at this writing.¹

The petition as considered under 37 C.F.R. §1.182 is **DISMISSED**.

BACKGROUND

The record reflects that:

- the instant application was filed on 20 August, 2003, and thereafter proceeded through initial application examination for formalities;
- following an improvidently mailed action (23 September, 2004) intended for another file but transmitted with the application number of the instant matter, Petitioner avers in a paper filed on 11 March, 2005, that he previously was in communication with the Examiner and received there from information as to certain future transactions, however,

¹ **NOTE:** Monitoring of the status of applications on PAIR can inform one's management of application responses and provide an indication when mailings of Office actions should be expected. Status Inquiries filed at three (3) or four (4) month intervals provide a demonstration of diligence and attention in supporting a petition seeking relief under 37 C.F.R. §1.181.

the record is silent as to these matters and Petitioner, as one registered to practice before the Office, is aware that all transactions before the Office are in writing;²

- on 12 September, 2005, Petitioner filed the instant petition seeking, *inter alia*, a new Office action or a clarification from the Office improvidently mailed action of 23 September, 2004, however, it is noted that the record reflects no action by Petitioner as to this matter following the 23 September, 2004, action other than submission of the 11 March, 2005 paper and the instant petition filed nine (9) months later;
- thereafter, the Examiner mailed a Restriction Requirement on 28 June, 2006, followed by a non-final Office action on 6 October, 2006, a final Office action on 1 June, 2007, and—after a request for continued examination (RCE)—a Notice of Non-Compliant Amendment mailed on 13 November, 2007, to which the Petitioner replied on 26 November, 2007.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)), and that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.³

² The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

³ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

ANALYSIS

Petitioner has sought relief under the provisions of 37 C.F.R. §1.182.⁴

However, before the instant petition was released from the technology center and forwarded to the Office of Petitions, the record is clear that the examination/prosecution activity sought by Petitioner occurred.

CONCLUSION

It appears that the issue herein is moot, and, therefore, the petition as under 37 C.F.R. §1.182 is **dismissed as moot**.

The instant application is released to Technology Center 1700 for further processing in due course.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁵) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



John J. Gillon, Jr.
Senior Attorney
Office of Petitions

⁴ The regulations at 37 C.F.R. §1.182 provide:

§ 1.182 Questions not specifically provided for.

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in §1.17(h).

⁵ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.